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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,052	05/14/2001	Uttandaraman Sundararaj	08CU-5777	8668

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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/855,052

Applicant(s)

SUNDARARAJ ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 11, 13, 14, 21 to 33, 35, 36, 43 to 50 and 57 to 60, is/are pending in the application.
- 4a) Of the above claim(s) 10, 11, 32 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 9, 13, 14, 21 to 31, 35, 36, 43 to 50 and 57 to 60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/13/04 has been entered.
2. Claims 1 to 9, 13, 14, 21, 22 and 46 to 50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' addition of the negative proviso is considered to be new matter. Applicants' arguments to the contrary are not persuasive. The negative limitation recited in the amended claims, which does not appear in the specification as filed, introduces new concepts and violates the description requirement of the first paragraph of 35 USC 112. Note that the express exclusion of certain elements implies the permissible inclusion of all other elements not so expressly excluded. This illustrates that such a negative limitation does, in fact, introduce new concepts. For instance the amended claims are now open to the addition of any catalyst not specifically excluded. This clearly was not described in the specification. There is nothing in the specification that conveys that applicant had possession of this particular concept. While the Examiner concedes that the specification is silent as to these catalysts, this does not support the position that, at the time this application was filed, applicants had possession of a composition that specifically excluded these catalysts. The Examiner does not believe that one having ordinary skill in the art would have realized that the specification supports the exclusion of the particular catalysts claimed. This is considered to be new matter.
3. For the record, the Examiner does not believe that the addition of the phrase "consisting essentially of" in claims 23 and 57 to 59 overcomes the prior art rejection

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made in the previous office action. This phrase excludes the presence of materials that materially affect the basic and novel characteristics of the invention and there is nothing that indicates that transparency is such a characteristic. However a new ground of rejection must be made for claims 1 and 46 (since the negative limitation must be considered even though it is new matter). In an effort to reduce the issues of obviousness, the Examiner has withdrawn all rejections based on Brown in favor of the following, comparable, grounds of rejection.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 to 9, 13, 14, 21 to 31, 35, 36, 43 to 50 and 57 to 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al. in view of Romensko et al.

This rejection relies on the same obviousness rationale as detailed in previous office actions, albeit with a different primary reference.

Cooper et al. teach blends of polyestercarbonate and polyetherimides. These polymers meet claimed components (a) and (b), as well as the particular requirements of claims 2 to 9. The limitations of claim 21 is found on column 12, lines 10 to 20.

Romensko et al. teach polysiloxanes meeting the formula and weight limitation of component (c) in claim 1. See for instance the gum having a Williams Plasticity number of 150 used in the examples which will inherently meet the claimed molecular weight requirement. This siloxane meets the requirements of claims 13 and 14. The top of column 4 teaches the various benefits of adding such a polysiloxane to thermoplastic compositions such as polycarbonates. This ingredient imparts flame retardancy.

Thus one having ordinary skill in the art would have been motivated by the teachings of Romensko et al. to add the silicone rubber powder of Romensko et al. to the blend of Cooper et al. in an effort to obtain the known benefits and properties associat-


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ed therewith. In this manner the instant claims are rendered obvious by this combination of references.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
9/23/04